



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jin-Soo Kim et al. Art Unit : 1636
Serial No. : 09/785,632 Examiner : T. McKelvey
Filed : February 16, 2001
Title : ZINC FINGER DOMAINS AND METHODS OF IDENTIFYING SAME

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF JUNE 20, 2005

The Examiner has rejected claims 1-11, 13-22, 32-33, 86, 88-93, and 95-98 as obvious over Barbas et al. (U.S. 6,242,568) and Cheng et al. (U.S. 5,869,250). The Applicants respectfully traverse below.

As an initial matter, the Applicants respectfully submit that the finality of the Office Action is premature and request that the Examiner withdraw the finality. The Examiner stated on page 4 of the Action that, "This is a new rejection necessitated by the applicant's amendment to the claims (removing the non-naturally occurring protein limitation) filed 4/4/05." It is unclear to the Applicants how the amendment necessitated the new rejection. Accordingly, the Applicants ask that the Examiner clarify for the record that re-introduction of the "non-naturally occurring protein" limitation would obviate the grounds for the new rejection. Absent such a conclusion, the rejection would not have been necessitated by the amendment. In which case, finality is premature pursuant to MPEP § 706.07(a).

Turning to the substance of the rejection of claims 1-11, 13-22, 32-33, 86, 88-93, and 95-98, the Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness because there is no reasonable expectation of success nor a motivation to combine.

The rejection noted that "Barbas does not specifically teach use of the in vivo method of identifying a modulating polypeptide taught by the reference. . ." Indeed, there is no reason to

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